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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,222	06/30/2006	Bernd Holl	VO-747	7594
42419 7590 08/21/2007 PAULEY PETERSEN & ERICKSON 2800 WEST HIGGINS ROAD SUITE 365 HOFFMAN ESTATES, IL 60195			EXAMINER KRECK, JOHN J	
			ART UNIT 3673	PAPER NUMBER
			MAIL DATE 08/21/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/564,222

Applicant(s)

HOLL ET AL.

Examiner

John Kreck

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-20 and 22-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Applicant's election without traverse of the species shown in figures 1 and 2 (i.e. the tool changing device exterior to the roller) in the reply filed on 7/16/07 is acknowledged.

Claims 4 and 21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species of invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7/16/07.

The substitute specification is entered.

### *Drawings*

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. The following claim features are missing from the drawings:

- " the displacement device" (claim 1);
- the "actuating unit" (claim 1, 6, 14, 15, 23, 27, 28);
- the "tool changing device imparting...dynamic pulse to...a group of chisel holders" (claim 2);
- " tool changer...assigned to... groups of the chisel holders" (claim 6, 23);
- "tool changer...simultaneously assigned to all of the chisels" (claim 7, 24);
- "a tool changer ...is respectively assigned to each of the chisel holders" (claim 8, 25);

tool changer "fixedly connected with the chisel holder" (claim 9);  
"position measuring system" (claim 15, 28);  
"conveying device" and "container" (claim 16, 29);  
"separating device" (claim 17, 30);  
"detection device" (claim 18, 19);  
"signal reception unit" (claim 19); and,  
"auxiliary motor" and "drive train" (claim 13, 26)

Each of these features must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3, 5-20, and 22-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

The claims are difficult to understand, but insofar as they are definite, they are rejected below.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 2, 3, 5, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Leonard (U.S. Patent number 4,329,766).

Leonard describes the construction machine having a milling roller ( D) with a plurality of arranged chisel holders ( S ); a chisel ( C ) in the holder; and a tool changing device ( 35, for removing; and T for inserting); and also teaches the tool changing device imparting a dynamic pulse (4: 30-40) as claimed.

Leonard also teaches a mechanical device as required by claim 3.

RE claim 10: the hammer shown in figure 5 is a vibration device.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 20, 22, 25, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leonard (U.S. Patent number 4,329,766 ) in view of Busley (U.S. Patent Application Publication number 2004/0021364).

Leonard describes the construction machine having a milling roller ( D) with a plurality of arranged chisel holders ( S ); a chisel ( C ) in the holder; and a tool changing device ( 35, for removing; and T for inserting)as claimed. Leonard lacks the at least one of the displacement device and actuating unit.

Busley (e.g. paragraphs 5-7) describes the advantages of a displacement device in a similar machine. Based on Busley's teaching, it would have been obvious to one of

ordinary skill in the art at the time of the invention to have modified the Leonard device to have the displacement device.

Leonard also teaches a mechanical device as required by claim 11.

RE claim 25: Leonard teaches a single tool changer assigned to a holder, not one assigned to each. See in re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced.

RE claim 26: see paragraphs 5-10 of Busley.

6. Claims 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leonard (U.S. Patent number 4,329,766 ) Leonard teaches a single tool changer assigned to a holder, not one assigned to each. See in re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced.

7. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leonard (U.S. Patent number 4,329,766 ) in view of EP1013829.

Leonard lacks the stop with contact face, and pulse generator.

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EP'829 describes a similar device with stop (30) and contact face, and pulse generator (28, etc..) as being advantageous for increasing the breaking force. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the Leonard tool to have stop, contact face, and pulse generator as claimed in claim 11.

EP'829 also describes the mallet as called for in claim 12.

8. Claims 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leonard (U.S. Patent number 4,329,766 and EP1013829 and further in view of Busley (U.S. Patent Application Publication number 2004/0021364).

Leonard lacks the at least one of the displacement device and actuating unit.

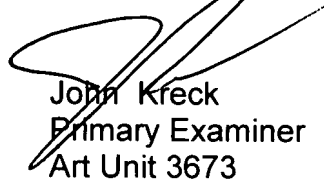
Busley (e.g. paragraphs 5-7) describes the advantages of a displacement device in a similar machine. Based on Busley's teaching, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the Leonard apparatus to have the displacement device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kreck whose telephone number is 571-272-7042. The examiner can normally be reached on Mon-Fri 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Engle can be reached on 571-272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John Kreck  
Primary Examiner  
Art Unit 3673

7 August 2007